

PATENT COOPERATION TREATY
PCT
INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

REC'D 16 JAN 2002

WIPO

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Applicant's or agent's file reference 2/8387/PC-JGA/TLA	FOR FURTHER ACTION	See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416).
International Application No. PCT/AU00/01081	International Filing Date (day/month/year) 8 September 2000	Priority Date (day/month/year) 8 September 1999
International Patent Classification (IPC) or national classification and IPC Int. Cl.⁷ G07D 7/00, 7/20, G07D 11/00, E05G 1/02		
Applicant ACCUDENT PTY LTD et al		

1.	This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.
2.	This REPORT consists of a total of 6 sheets, including this cover sheet. <input checked="" type="checkbox"/> This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT). These annexes consist of a total of 8 sheet(s).
3.	This report contains indications relating to the following items: I <input checked="" type="checkbox"/> Basis of the report II <input type="checkbox"/> Priority III <input type="checkbox"/> Non-establishment of opinion with regard to novelty, inventive step and industrial applicability IV <input checked="" type="checkbox"/> Lack of unity of invention V <input checked="" type="checkbox"/> Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement VI <input type="checkbox"/> Certain documents cited VII <input type="checkbox"/> Certain defects in the international application VIII <input type="checkbox"/> Certain observations on the international application

Date of submission of the demand 6 April 2001	Date of completion of the report 7 January 2002
Name and mailing address of the IPEA/AU AUSTRALIAN PATENT OFFICE PO BOX 200, WODEN ACT 2606, AUSTRALIA E-mail address: pct@ipaaustralia.gov.au Facsimile No. (02) 6285 3929	Authorized Officer P. THONG Telephone No. (02) 6283 2128

I. Basis of the report

1. With regard to the **elements** of the international application:*
- ☐ the international application as originally filed.
- ☒ the description, pages **1-24**, as originally filed,
pages , filed with the demand,
pages , received on with the letter of
- ☒ the claims, pages , as originally filed,
pages , as amended (together with any statement) under Article 19,
pages , filed with the demand,
pages **25-28**, received on **3 September 2001** with the letter of **3 September 2001**
pages **29-32**, received on **19 December 2001** with the letter of **19 December 2001**
- ☒ the drawings, pages **1/7-7/7**, as originally filed,
pages , filed with the demand,
pages , received on with the letter of
- ☐ the sequence listing part of the description:
pages , as originally filed
pages , filed with the demand
pages , received on with the letter of
2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.
These elements were available or furnished to this Authority in the following language which is:
- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).
3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:
- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished
4. ☐ The amendments have resulted in the cancellation of:
- ☐ the description, pages
- ☐ the claims, Nos.
- ☐ the drawings, sheets/fig.
5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).**

* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17).

** Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report

IV. Lack of unity of invention

1. In response to the invitation to restrict or pay additional fees the applicant has:

- ☐ restricted the claims.
- ☐ paid additional fees.
- ☐ paid additional fees under protest.
- ☐ neither restricted nor paid additional fees.

2. ☒ This Authority found that the requirement of unity of invention is not complied with and chose, according to Rule 68.1, not to invite the applicant to restrict or pay additional fees.

3. This Authority considers that the requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is

- ☐ complied with.
- ☒ not complied with for the following reasons:

(1) Claims 1-12,14-17 relate to a document authentication method or device.
The authentication method or device comprises a first "special technical feature".

(2) Claim 13,18-29 relate to a document receptacle not requiring the same authentication method or device. The receptacle comprises a second "special technical feature".

Since the abovementioned groups of claims do not share any of the technical features identified, a "technical relationship" between the inventions, as defined in PCT rule 13.2 does not exist. Accordingly the international application does not relate to one invention or to a single inventive concept, a priori.

4. Consequently, the following parts of the international application were the subject of international preliminary examination in establishing this report:

- ☒ all parts.
- ☐ the parts relating to claims Nos.

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**1. Statement**

Novelty (N)	Claims	13,19,20,22,24,27,29	YES
	Claims	1-12,14-18,21,23,25,26,28	NO
Inventive step (IS)	Claims	13,19,20,22,24,27,29	YES
	Claims	1-12,14-18,21,23,25,26,28	NO
Industrial applicability (IA)	Claims	1-29	YES
	Claims		NO

2. Citations and explanations (Rule 70.7)

NOVELTY (N): Claims 1-12,14-18,21,23,25,26,28

D1 = US 5818021 D2 = WO 99/04364 D3 = US 5895073 D4 = US 5790245 D5 = FR 2605674

NEW CITATIONS (cited in the third opinion):

D6 = US 5619025 D7 = US 5740244 D8 = US 5920628 D9 = US 5923413

NEW CITATION (cited in the fourth opinion):

D10 = US 5607040

NEW CITATIONS:

D11 = United States Patent Re. 28731 A (BURGIN) 9 March 1976

D12 = FR 2755777 (GUITTON BRUNO MARCEL GEORGES) 15 May 1998

D13 = WO 99/28846 (DIEBOLD, INCORPORATED) 10 June 1999

Claims 1-12,14-16

In the context of the claims and the description, the term "pre-existing" would only suggest that the identifying features and/or indicia were in place prior to a "re-scanning" operation of an authentication process. All the identifying features in the above citations are already in place prior to a scanning operation and are therefore "pre-existing" or old. Consequently, the claims in general are anticipated by the citations.

Claims 1-12

In view of the above, the features in claims 1 to 12 are generally anticipated. Citation D1 (like citation D8 for example) discloses:-

- i) scanning and transmission of scanned "pre-existing" identifying features to a central computer (column 3 line 65 to column 4 line 3)
- ii) authentication of scanned "pre-existing" identifying features at the central computer (column 4 lines 4 to 10)
- iii) returning a confirmation signal on authentication via optical fibres (column 2 lines 65 to 67).

Such disclosures in citation D1 (and the other citations) render the claimed features not novel.

NOTE: Refer to the next Supplemental Box.

Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of Box V-2 (Citations and explanations)Claims 14-16

The features in these claims are disclosed. For example, each note in citation D1 (or D8) is uniquely identified, anticipating the feature in claim 14. The method in citation D4 involves scanning a document at more than one position, anticipating the feature in claim 15. The comparison of scanned identifying features with previously scanned identifying features is clearly disclosed in citations D6 to D8, anticipating the feature of claim 16.

Claim 17

Claim 17 is directed to a specific arrangement that involves the scanning of a bank note for printed serial number wherein "the bank note is not modified or altered to enable the scanning to be effected". While it is uncertain as to what is meant by the phrase "the bank note is not modified or altered to enable the scanning to be effected" given that all the banknotes as described must somehow be modified or altered to carry a scannable indicia (serial number for example), it is likely that the phrase is intended to limit the practice of the claimed authenticating method to notes that are already in circulation. Irrespective of what is actually intended, the claimed arrangement as currently drafted can not be considered novel in the light of US 5607040. This citation (column 10 lines 35 to 45 in particular) discloses that serial numbers of a banknote that is in circulation may be scanned and compared to a database of serial numbers for authentication purposes.

Claims 18,21,23,25,26,28

Citation D11 (column 3 lines 37 to 47) discloses an apparatus in which a card (effectively an identification document) is scanned for authentication purpose. The card is returned to a user if found to be authentic or retained in the apparatus (receptacle) if found to be not authentic. Such disclosures anticipate the arrangement in at least claims 18 and 26.

Citation D12 (page 2 line 18 to 23) discloses an apparatus that scans a banknote for authentication purposes. The apparatus is programmed to release the banknote if the latter is genuine. If the banknote is not genuine, the apparatus retains the banknote. Citation D13 discloses an apparatus that scans a document for authentication purposes as the document enters and exits the apparatus. Such disclosures anticipate the arrangement in claims 18,21,23,25,26 and 28.

NOTE: Refer to the next Supplemental Box.

Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of Box V-2 (Citations and explanations)**INVENTIVE STEP (IS): Claims 1-12,14-18,21,23,25,26,28****Claims 1-12,14-16**

As above.

It is also noted that the features added by the additional appended claims 14 to 16 do not contribute to patentable invention. Claim 16 for example involves the removal of changed or damaged documents from circulation. The use or disuse to which a rejected document is put has no effect on the working of the invention and is also common general knowledge (see column 14 line 33 of citation D9 for example).

Claim 17,18,21,23,25,26,28

As above.

(12) INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

(19) World Intellectual Property Organization
International Bureau



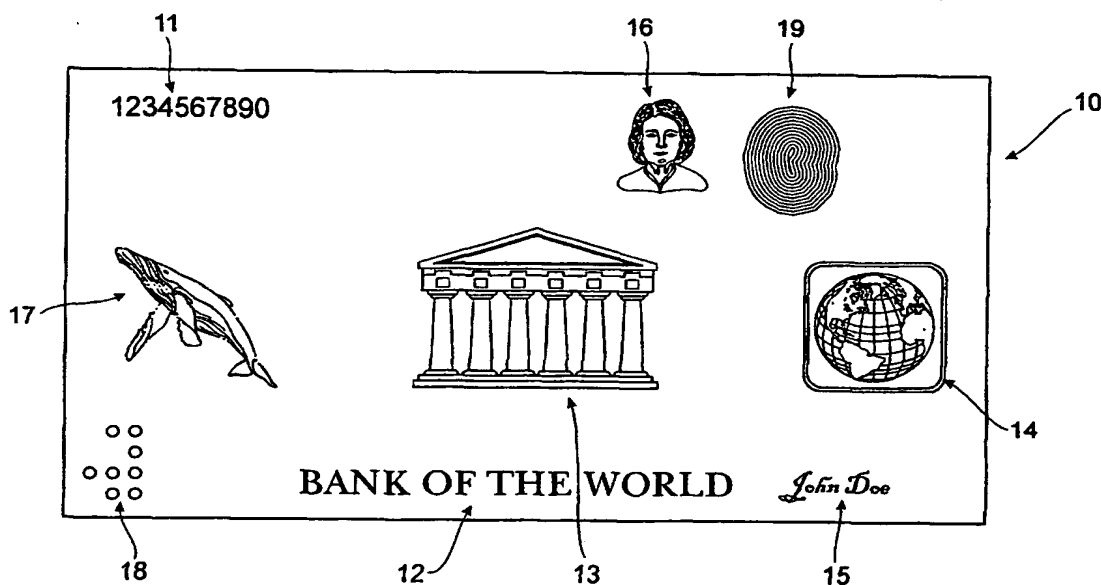
(43) International Publication Date
15 March 2001 (15.03.2001)

PCT

(10) International Publication Number
WO 01/18754 A1

- (51) International Patent Classification⁷: G07D 7/00, 7/20, 11/00, E05G 1/02 (74) Agent: FISHER ADAMS KELLY; Level 13, AMP Place, 10 Eagle Street, Brisbane, Queensland 4000 (AU).
- (21) International Application Number: PCT/AU00/01081 (81) Designated States (*national*): AE, AG, AL, AM, AT, AU, AZ, BA, BB, BG, BR, BY, BZ, CA, CH, CN, CR, CU, CZ, DE, DK, DM, DZ, EE, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MZ, NO, NZ, PL, PT, RO, RU, SD, SE, SG, SI, SK, SL, TJ, TM, TR, TT, TZ, UA, UG, US, UZ, VN, YU, ZA, ZW.
- (22) International Filing Date: 8 September 2000 (08.09.2000)
- (25) Filing Language: English
- (26) Publication Language: English
- (30) Priority Data: PQ 2737 8 September 1999 (08.09.1999) AU (84) Designated States (*regional*): ARIPO patent (GH, GM, KE, LS, MW, MZ, SD, SL, SZ, TZ, UG, ZW), Eurasian patent (AM, AZ, BY, KG, KZ, MD, RU, TJ, TM), European patent (AT, BE, CH, CY, DE, DK, ES, FI, FR, GB, GR, IE, IT, LU, MC, NL, PT, SE), OAPI patent (BF, BJ, CF, CG, CI, CM, GA, GN, GW, ML, MR, NE, SN, TD, TG).
- (71) Applicant (*for all designated States except US*): ACCU-DENT PTY LTD [AU/AU]; 7 Jimna Street, The Gap, Queensland 4061 (AU).
- (72) Inventor; and
- (75) Inventor/Applicant (*for US only*): GRAHAM, Martin, Alan, Scott [AU/AU]; 7 Jimna Street, The Gap, Queensland 4061 (AU).
- Published:
— With international search report.
- For two-letter codes and other abbreviations, refer to the "Guidance Notes on Codes and Abbreviations" appearing at the beginning of each regular issue of the PCT Gazette.

(54) Title: DOCUMENT AUTHENTICATION METHOD AND APPARATUS



(57) Abstract: Documents (eg., bank notes, travellers cheques, credit cards) (10) are authenticated by scanning the documents for one or more identifying features and/or indicia (11-19), comparing the scanned features/indicia (11-19) with stored information in a database and transmitting a signal indicating the authenticity, or otherwise, of the documents (10). In another aspect, documents that are being deposited into a receptacle are scanned for identifying features and/or indicia and the features and/or indicia are recorded in a card. Access to the documents in the receptacle is possible only by the presentation of the card to a reader associated with the receptacle.

WO 01/18754 A1

INTERNATIONAL SEARCH REPORT

International application No.

PCT/AU00/01081

A. CLASSIFICATION OF SUBJECT MATTERInt. Cl. ⁷: G07D 7/00, 7/20, G07D 11/00, E05G 1/02

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)
 WPAT, USPTO Web Patent Database, Esp@cenet, "document, banknote, currency, genuine, authentic, database, compare, wallet, purse, safe, scan, card etc"

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	US, A, 5818021 (SZEWCZYKOWSKI) 6 October 1998 Entire document.	1-12
X	WO, A, 99/04364 (ASSURE SYSTEMS, INC) 28 January 1999 Entire document.	1-12
X	US, A, 5895073 (MOORE) 20 April 1999 Entire document.	1-12
X	US, A, 5790245 (KANESASHI) 4 August 1998 Entire document.	1-12
A	FR, A, 2605674 (VAUTHERIN) 29 April 1988 Entire document.	13

☐

Further documents are listed in the continuation of Box C

☒

See patent family annex

* Special categories of cited documents:

"A" Document defining the general state of the art which is not considered to be of particular relevance
 "E" earlier application or patent but published on or after the international filing date
 "L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)
 "O" document referring to an oral disclosure, use, exhibition or other means
 "P" document published prior to the international filing date but later than the priority date claimed

"T"

later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
 "X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
 "Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art
 "&" document member of the same patent family

Date of the actual completion of the international search

7 November 2000

Date of mailing of the international search report

16 NOV 2000

Name and mailing address of the ISA/AU

AUSTRALIAN PATENT OFFICE
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INTERNATIONAL SEARCH REPORT
Information on patent family members

International application No.
PCT/AU00/01081

This Annex lists the known "A" publication level patent family members relating to the patent documents cited in the above-mentioned international search report. The Australian Patent Office is in no way liable for these particulars which are merely given for the purpose of information.

Patent Document Cited in Search Report				Patent Family Member			
US	5818021	WO	98/25212	US	6039249		
WO	99/04364	AU	85778/98	EP	996928		
US	5895073	US	5917925	CA	2192745	GB	2312307
US	5790245	JP	8305922	KR	205778		
END OF ANNEX							

INTERNATIONAL SEARCH REPORT

International application No.

PCT/AU00/01081

Box I Observations where certain claims were found unsearchable (Continuation of item 2 of first sheet)

This international search report has not been established in respect of certain claims under Article 17(2)(a) for the following reasons:

1. ☐ Claims Nos :
because they relate to subject matter not required to be searched by this Authority, namely:
2. ☐ Claims Nos :
because they relate to parts of the international application that do not comply with the prescribed requirements to such an extent that no meaningful international search can be carried out, specifically:
3. ☐ Claims Nos :
because they are dependent claims and are not drafted in accordance with the second and third sentences of Rule 6.4(a)

Box II Observations where unity of invention is lacking (Continuation of item 3 of first sheet).

This International Searching Authority found multiple inventions in this international application, as follows:

- (1) Claims 1-12. Document authentication method or device.
 - (2) Claim 13. Document receptacle not requiring the same authentication method or device.
1. ☐ As all required additional search fees were timely paid by the applicant, this international search report covers all searchable claims
 2. ☒ As all searchable claims could be searched without effort justifying an additional fee, this Authority did not invite payment of any additional fee.
 3. ☐ As only some of the required additional search fees were timely paid by the applicant, this international search report covers only those claims for which fees were paid, specifically claims Nos.:
 4. ☐ No required additional search fees were timely paid by the applicant. Consequently, this international search report is restricted to the invention first mentioned in the claims; it is covered by claims Nos.:

Remark on Protest

- ☐ The additional search fees were accompanied by the applicant's protest.
- ☐ No protest accompanied the payment of additional search fees.

INTERNATIONAL SEARCH REPORT
Information on patent family members

International application No.
PCT/AU00/01081

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(2) Claim 13. Document receptacle not requiring the same authentication method or device.

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Remark on Protest

☐ The additional search fees were accompanied by the applicant's protest.☐ No protest accompanied the payment of additional search fees.

CLAIMS

1. A method for authenticating a document including the steps of:
- 5 a) scanning the document for one or more identifying features and/or indicia;
- b) comparing the scanned features/indicia against stored information in a database identifying the features/indicia as authentic or otherwise; and
- 10 c) transmitting a signal confirming whether or not the document is authentic or otherwise.
2. A method as claimed in Claim 1 wherein:
- the features/indicia scanned include watermarks, holograms, serial numbers, words, devices, colours, patterns, combinations, or other features or indicia printed on, embossed into,
- 15 incorporated in, or otherwise forming part of, the document.
3. A method as claimed in Claim 2 wherein:
- the database contains one or more features/indicia for comparison by which the authentication of the document may be determined.
- 20 4. A method as claimed in Claim 1 wherein:
- the document is authenticated when the features/indicia scanned match the criteria of one or more identification components stored in the database.

5. A method as claimed in Claim 1 wherein:

when a document is established to be authentic or otherwise, the signal is transmitted to the location at which the document is scanned to indicate whether or not the document is authentic or otherwise and/or to one or more alternative locations.

6. An apparatus for authenticating a document including:

a terminal operable to scan one or more identifying features or indicia of the document;

a database containing one or more stored identifying features indicative of whether or not the document is authentic or otherwise;

comparator means to compare the scanned features/indicia with the stored identifying features;

transmission means interconnecting the scanning means and the comparator means; and

indicator means operable to receive a signal from the comparator means to indicate whether or not the document is authentic or otherwise.

7. Apparatus as claimed in Claim 6 wherein:

the indicator means is provided on the terminal, and one or more indicator means are optionally provided at alternative locations, eg., a bank security unit.

8. Apparatus as claimed in Claim 6 wherein:

the terminal includes scanning means operable to scan the scanned features/indicia, and means to transport the document past the scanning means.

9. Apparatus as claimed in Claim 8 wherein:

5 the scanning means incorporates one or more scanning heads, each operable to scan one or more features/indicia on the documents.

10. Apparatus as claimed in Claim 6 wherein:

the database is provided on a central computer which
10 incorporates the comparator means.

11. Apparatus as claimed in Claim 6 wherein:

the transmission means incorporates any suitable communication means, including telephony, wireless, infra-red, hardware or the like.

15 12. Apparatus as claimed in Claim 8 or Claim 9 wherein:

the scanning means is a scanning head passed over the documents by hand.

13. An apparatus for authenticating a document including;

a receptacle to receive the document;
20 means to scan the document as the document enters the receptacle;

data transfer means to transfer scanned data from the scanning means;

and card means operable to receive the data; so
arranged that:

the document can only be released from the receptacle
when the card means is placed in, or read by, a card reader
5 associated with the receptacle.

INTERNATIONAL SEARCH REPORT

International application No.
PCT/AU00/01081

A. CLASSIFICATION OF SUBJECT MATTER

Int. Cl. ⁷: G07D 7/00, 7/20, G07D 11/00, E05G 1/02

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Minimum documentation searched (classification system followed by classification symbols)

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

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WPAT, USPTO Web Patent Database, Esp@cenet, "document, banknote, currency, genuine, authentic, database, compare, wallet, purse, safe, scan, card etc"

C. DOCUMENTS CONSIDERED TO BE RELEVANT

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"O" document referring to an oral disclosure, use, exhibition or other means
"P" document published prior to the international filing date but later than the priority date claimed

"T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
"X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
"Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art
"&" document member of the same patent family

Date of the actual completion of the international search

7 November 2000

Name and mailing address of the ISA/AU

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Facsimile No. (02) 6285 3929

Date of mailing of the international search report

16 NOV 2000

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Telephone No : (02) 6283 2128